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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,341	04/05/2001	Joseph L. Burquist	10004362-1	5252

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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,341

Applicant(s)

BURQUIST ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 5/10/05.
- Claims 1-35 are pending in application.

Response to Amendment

The affidavit filed on 4/27/05 under 37 CFR 1.131 is sufficient to overcome the US 6377758 to OuYang) reference.

Response to Arguments

Applicant's arguments, see page 2 of Affidavit Under 37 CFR 1.131, filed 4/27/05, with respect to the rejection(s) of claim(s) 1-5, 12-13, 21 and 35 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference (see prior art rejections below for details).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Limitations as cited in claims 13 and 28 are unclear and confusing. The examiner is unclear whether "first image" is generated from a personal computer and/or from other external sources. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 21, 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Moscato et al (US 6335978).

Regarding claim 1, Moscato discloses a system (system 10 for verifying document, fig. 1) for verifying a document comprising:

- first means (RIP 11 for providing image data, fig. 1) for providing a first electronic image (original image 13, fig. 1) of a document;
- second means (imaging device 15, fig. 1) for providing a second electronic image (printed image 21, fig. 1) of a document; and
- third means (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) for comparing said first and second electronic images and providing an output (output response 22 as shown in fig. 1, col. 3, lines 35-65) response thereto.

Regarding claim 2, Moscato further discloses the invention of claim 1 wherein said second image is derived from said first image (image 21 is derived from original image 13 via printer 15, fig. 1, col. 3, lines 35-65).

Regarding claim 3, Moscato further discloses the invention of claim 1 wherein said second means includes a scanner (scanner 20, fig. 1, and scanner 20 can also be incorporated within printer 15, fig. 3).

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Regarding claim 4, Moscato further discloses the invention of claim 3 wherein said second means includes a printer (printer 15, figs. 1 and 3).

Regarding claim 5, Moscato further discloses the invention of claim 4 wherein said scanner (scanner 20, fig. 1, and scanner 20 can also be incorporated within printer 15, fig. 3) is mounted to scan a document printed by said printer to provide said second image.

Regarding claim 21, Moscato further discloses a system (system 10 for verifying document, fig. 1) for verifying a printed document comprising:

- a computer (RIP 11 for providing image data, fig. 1) for providing a first electronic image (original image 13, fig. 1) of a document;
- a printer (imaging device 15, fig. 1) coupled to said computer;
- a scanner (scanner 20, fig. 1) adapted to scan a document printed by said printer to provide a second electronic image (printed image 21, fig. 1) of said document; and
- software (comparison device 12, fig. 1, and inherently, comparison device 12 includes a computer instruction program for comparing original image with printed image) for comparing said first and second electronic images (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) and providing an output response thereto (output response 22 as shown in fig. 1, col. 3, lines 35-65).

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Regarding claim 35: Claim 35 is a method that corresponding to the apparatus and recite limitations that are similar and in the same scope of invention as to those in claim 1; therefore, claim 35 is rejected for the same rejection rationale/basis as described in claim 1 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato as described in claims 1-5 above, and in view of Bolle et al (U.S. 5963656).

Regarding claim 6, Moscato does not expressly disclose a verification system includes means for adding a fingerprint to an image.

Bolle, in the same field of endeavor for verification system, teaches a verifying includes means for adding a fingerprint to an image (fig. 7 shows a verification system for adding a fingerprint taking by camera 760 onto the document, col. 5, lines 18-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify print system of Moscato to include a means for adding a fingerprint to an image as per teachings of Bolle because of a following reason: (●) to add more security to the confidential documents by incorporating fingerprints onto the documents as being processed by Moscato.

Therefore, it would have been obvious to combine Moscato with Bolle to obtain the invention as specified in claim 6.

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Regarding claim 7, Bolle further teaches means for printing said fingerprint on said document (documents with fingerprint, col. 5, lines 18-28).

Regarding claim 8, Bolle further teaches a scanner is adapted to scan said fingerprint and provide a fingerprint output signal in response thereto (scanner 765, fig. 7).

Regarding claims 22-24 recite limitations that are similar and in the same scope of invention as to those in claims 6-8 above; therefore, claims 22-24 are rejected for the same rejection rationale/basis as described in claims 6-8.

Claims 9 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato and Bolle as described in claims 6-8 and 22-24 above, and further in view of Yamaguchi et al (U.S. 5390003).

Regarding claims 9 & 25, the combinations of Moscato and Bolle does not teach a means responsive for inhibiting printer.

Yamaguchi, in the same field of endeavor for verification system, teaches a means responsive for inhibiting printer (abstract, cols. 2-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the inventions of Moscato and Bolle to include a means responsive for inhibiting printer as per teachings of Yamaguchi because of a following reason: (●) to prevent unauthorized reproduction of confidential contents/documents (Yamaguchi, abstract and cols. 2-4), please refer to claim 6 for additional motivation.

Therefore, it would have been obvious to combine Moscato, Bolle with Yamaguchi to obtain the invention as specified in claims 9 & 25.

Claims 10-20, 26--34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato as described in claim 1 above, and in view of Yamaguchi et al (U.S. 5390003).

Regarding claims 10-11, Moscato does not expressly disclose wherein a printing system including means for detecting print restriction and to disable the printing of confidential contents.

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Yamaguchi, in the same field of endeavor for printing system, teaches that it is well known in the art at the time of the invention an image forming apparatus including a means for detecting print restriction and to disable the printing of confidential contents (image forming apparatus includes means for preventing and prohibiting confidential contents such as money to be reproduced, abstract and cols. 2-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Moscato to include a means for detecting print restriction and to disable the printing of confidential contents as per teachings of Yamaguchi because of a following reason: (●) to prevent unauthorized reproduction of confidential contents/documents (Yamaguchi, abstract and cols. 2-4).

Therefore, it would have been obvious to combine Moscato with Yamaguchi to obtain the invention as specified in claims 10-11.

Regarding claims 12-13, Yamaguchi further discloses first means includes a personal computer, and wherein first image is provided to said computer via a network (personal computer and network is widely known and available in the art, see fig. 1).

Regarding claim 14, Yamaguchi further discloses communication network is Internet (fig. 4). Internet communications are widely available and known in the art.

Regarding claims 15-17, Yamaguchi further discloses wherein said software is stored in memory in scanner, computer, and printer (it is known in the art that all scanners, printers, and computers contain storage memory for storing computer programs, figs. 4-5, cols. 2-4).

Regarding claims 18-20, a method and/or system for converting image into text (OCR, optical converting image into texts are widely known in the art and also admitted by the applicant).

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Regarding claims 26-27 recite limitations that are similar and in the same scope of invention as to those in claims 10-11 above; therefore, claims 26-27 are rejected for the same rejection rationale/basis as described in claims 10-11.

Regarding claims 28-29 recite limitations that are similar and in the same scope of invention as to those in claims 14 above; therefore, claims 28-29 are rejected for the same rejection rationale/basis as described in claims 14.

Regarding claims 30-34 recite limitations that are similar and in the same scope of invention as to those in claims 16-20 above; therefore, claims 30-34 are rejected for the same rejection rationale/basis as described in claims 16-20.

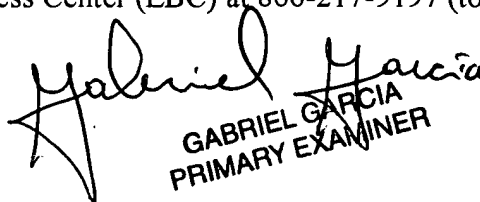
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER